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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/717,321	11/20/2000	Bonnie Gould Rothberg	15966-601 (Cura 101)	1397
30623	7590	12/18/2003	EXAMINER	
MINTZ, LEVIN, COHN, FERRIS, GLOVSKY AND POPEO, P.C. ONE FINANCIAL CENTER BOSTON, MA 02111			VOGEL, NANCY T	
			ART UNIT	PAPER NUMBER
			1636	

DATE MAILED: 12/18/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. 09/717,321	Applicant(s) ROTHBERG ET AL.	
	Examiner Nancy Vogel	Art Unit 1636	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 24 October 2003.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 48-51, 54, 55, 58-62, 64-68, 70-74 and 76-79 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 76-79 is/are allowed.
- 6) ☒ Claim(s) 48-51, 54, 55, 58-62, 64-68 and 70-74 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. §§ 119 and 120**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                             | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____                                    |

### **DETAILED ACTION**

Claims 48-51, 54, 55, 58-62, 64-68, 70-74, and 76-79 are pending in the case.

Receipt of the amendment after final rejection on 10/24/03 is acknowledged.

The indicated allowability of claims 48-51, 55, 58-62, 64-68, and 70-74 is withdrawn in view of the new rejection that follows. The finality of the previous Office action is hereby withdrawn.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 48-51, 54, 55, 58-62, 64-68, and 70-74 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The specification discloses SEQ ID NOs: 1, 2, 15 and 17, which are partial cDNA molecules. The specification does not address whether the cDNAs cross an exon/intron splice junction. The claims are drawn to 4 separate genes, i.e., any nucleic acid that minimally contains SEQ ID NOs: 1, 2, 15, or 17 within it including any full length gene which contains the sequence, any fusion constructs, or cDNAs, (and vectors, cells and

compositions comprising said nucleic acids). There are single species disclosed within each genus, which are SEQ ID NOs: 1, 2, 15, and 17. The disclosure of a single disclosed species may provide an adequate written description of a genus when the species disclosed is representative of the genus. The present claims encompass full-length genes and cDNAs that are not further described. There is substantial variability among the species of DNAs encompassed within the scope of the claims because SEQ ID NOs: 1, 2, 15 and 17 are only fragments of any full-length genes or cDNA species. When reviewing a claim that encompasses a widely varying genus, the examiner must evaluate any necessary common attributes or features. In the case of a partial cDNA sequence that is claimed with open language (comprising), the genus of, e.g., "A cDNA comprising [a partial sequence]", encompasses a variety of subgenera with widely varying attributes. For example, a cDNA's principle attribute would include its coding region. A partial cDNA that did not include a disclosure of any open reading frame (ORF) of which it would be a part, would not be representative of the genus of cDNAs because no information regarding the coding capacity of any cDNA molecule would be disclosed. Further, defining "the" cDNA in functional terms would not suffice in the absence of a disclosure of structural features or elements of a cDNA that would encode a protein having a stated function.

A description of a genus of cDNAs may be achieved by means of a recitation of a representative number of cDNAs, defined by nucleotide sequence, falling within the scope of the genus or of a recitation of structural features common to the members of the genus, which features constitute a substantial portion of the genus. Regents of the

University of California v. Eli Lilly & Co., 119 F3d 1559, 1569, 43 USPQ2d 1398, 1406 (Fed. Cir. 1997).

Here, the specification discloses only a single common structural feature shared by members of the claimed genres, i.e. SEQ ID NOs: 1, 2, 15, or 17. Since the claimed genres encompasses genes yet to be discovered, DNA constructs that encode fusion proteins, etc., the disclosed structural features do not "constitute a substantial portion" of the claimed genres. Therefore, the disclosure of SEQ ID NOs: 1, 2, 15 and 17 do not provide an adequate description of the claimed genres.

Weighing all factors, 1) partial structure of the DNAs that comprise SEQ ID NOs: 1, 2, 15 or 17, 2) the breadth of the claims as reading on genes yet to be discovered in addition to numerous fusion constructs and cDNAs, 3) the lack of correlation between the structure and the function of the genes and/or fusion constructs; in view of the level of knowledge and skill in the art, one skilled in the art would not recognize from the disclosure that the applicant was in possession of the genres of DNAs which comprise SEQ ID NOs: 1, 2, 15 or 17.

Claims 76-79 are allowed.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nancy Vogel whose telephone number is (703) 308-4548. The examiner can normally be reached on 7:30 - 4:00, Monday - Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Irem Yucel, Ph.D. can be reached on (703) 305-1998. The fax phone number for the organization where this application or proceeding is assigned is (703) 305-3014.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196. After January 13, 2003, the examiner's phone number will be (571) 272-0780.

ntv

  
TERRY MCKELVEY  
PRIMARY EXAMINER